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Paper No. 13  
CEW

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB                      AUG. 21,98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Lerner New York, Inc.

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Serial No. 74/659,196

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Frank J. Colucci of Colucci & Umans for applicant.

Kim Saito, Trademark Examining Attorney, Law Office 109  
(Deborah S. Cohn, Managing Attorney).

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Before Cissel, Hairston and Walters, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Lerner New York, Inc. has filed a trademark application  
to register the mark shown below for "denim clothing,  
namely, shirts, shorts, pants, skirts."<sup>1</sup> The application



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<sup>1</sup> Serial No. 74/659,196, in International Class 25, filed April 11, 1995, based on an allegation of a bona fide intention to use the mark in commerce.

includes a disclaimer of JEANS apart from the mark as a whole.

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark NY, previously registered for "clothing, namely, shirts and uniform jerseys,"<sup>2</sup> that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Additionally, the Examining Attorney has finally refused registration under Section 2(e)(2) of the Trademark Act, 15 U.S.C. 1052(e)(2), on the ground that the term NY in applicant's mark is a known abbreviation for "New York"; that the primary significance of the mark as a whole is geographic; and that there is a strong goods/place association between New York and the "garment industry."

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs and an oral hearing was held. We affirm the refusal to register on both grounds.

Before considering the merits of the refusals in this case, we address the fact that applicant has submitted with its brief information regarding third-party registrations; and that the Examining Attorney has objected to this

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<sup>2</sup> Registration No. 1,898,998 issued June 13, 1995, to New York Yankees partnership composed of Joseph A. Molloy, in International Class 25. The registration includes a claim of acquired distinctiveness under Section 2(f).

submission as untimely. We find the Examining Attorney's objection to be well taken and we have not considered this evidence.<sup>3</sup> Applicant did not comply with the established rule that the evidentiary record in an application must be complete prior to the filing of the notice of appeal. See, 37 CFR 2.142(d); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).

*Likelihood of Confusion*

In the analysis of likelihood of confusion in this case, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering, first, the goods, we agree with the Examining Attorney that some of the applicant's and registrant's goods are identical, i.e., applicant's denim shirts are encompassed by registrant's shirts, and the remaining identified goods of the parties are closely related items of clothing. In fact, as the Examining Attorney notes, "uniform jerseys," as identified in the registration, are a type of shirt, albeit for a specific purpose.

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<sup>3</sup> We hasten to add that, had we considered this evidence, our decision on the substantive issues in this case would remain the same.

It is immaterial that, as applicant argues, its goods are sold only in its specialty stores and only with hang tags identifying applicant as Lerner or Lerner New York; and that registrant's goods are "sporting goods or professional sports team memorabilia or souvenirs" which would not be sold in applicant's stores. "The question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the] registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

While applicant's identified clothing items are limited to those made of denim, the applicant's and registrant's goods are otherwise broadly worded and, except for registrant's "uniform jerseys" which are encompassed in its identified "shirts," the applicant's and registrant's goods are not limited as to style or function. Therefore, we may reasonably presume that the goods of the applicant and registrant are sold in all of the normal channels of trade to all of the normal purchasers for goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). That is, we may presume that the goods of applicant and registrant are sold

through the same channels of trade to the same classes of ordinary purchasers.

We begin our consideration of the marks by noting that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In this case, applicant's mark encompasses registrant's mark, NY, in its entirety. The question is whether applicant's mark, considered in its entirety, is sufficiently different from registrant's mark to avoid a likelihood of confusion. We answer this question in the negative. Applicant's mark consists of the term NY followed by the generic term JEANS, in letters approximately half the size of NY. NY JEANS is enclosed in a simple rectangle which serves merely as a border. As such, the dominant portion of the mark is clearly the term NY. Considering applicant's mark in its entirety, we conclude that there is sufficient similarity in the commercial impressions of applicant's mark, NY JEANS and design, and registrant's mark, NY, that their contemporaneous use on the same and closely related goods

involved in this case is likely to cause confusion as to the source or sponsorship of such goods.<sup>4</sup>

*Geographic Descriptiveness*

In order for registration to be properly refused under Section 2(e)(2), it is necessary to show that (i) the mark sought to be registered is the name of a place known generally to the public, and that (ii) the public would make a goods/place association, that is, believe that the goods or services for which the mark is sought to be registered originate in that place. See, e.g., *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1402 (TTAB 1994); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988), citing *In re Societa Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).

If these conditions are met, and the goods come from the place named by or in the mark, the mark is primarily geographically descriptive. Moreover, where there is no genuine issue that the geographical significance of a term is its primary significance, and where the geographical place named is neither obscure nor remote, a public association of the goods with the place may ordinarily be

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<sup>4</sup> We find little merit to applicant's argument that the connotation of NY differs in the two marks. There is nothing in the nature of the marks themselves which indicates different connotations of NY. Applicant's argument appears to presuppose that the applicant's and registrant's goods are expressly limited, which they are not, in

presumed from the fact that the applicant's goods come from the geographical place named in the mark. *See, e.g., In re California Pizza Kitchen, Inc., supra;* and *In re Handler Fenton Westerns, Inc.,* 214 USPQ 848, 850 (TTAB 1982).

The record establishes, and applicant does not dispute, that NY is a known and common abbreviation for "New York." There is no question that New York is neither a remote nor obscure geographic location. Rather, it is the name of a place generally known to the public. Further, we conclude that the additional term, JEANS, and the design added to applicant's mark do not detract from the primary geographic significance of the composite mark. *See, In re Chalk's International Airlines Inc.,* 21 USPQ2d 1637, 1639 (TTAB 1991). Moreover, as the Board has stated in the past, the determination of registrability under what was then Section 2(e)(2) [and now is Section 2(e)(3)] should not depend on whether the mark is unitary or a composite. *See, In re Cambridge Digital Systems,* 1 USPQ2d 1659, 1662 (TTAB 1986). Thus, the first prong of the test is met.

As indicated in the application, applicant is located in New York and, as applicant states in its brief, its stores are located nationwide, including, presumably, New York. Thus, a principal origin of applicant's goods is New York, notwithstanding the fact that goods may be

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registrant's case to clothing related to the Yankees' baseball team, and

manufactured, for example, in China or Mexico. Applicant's location and the circumstances surrounding the production and marketing of the goods must be considered to determine the origin of the goods as that is likely to be understood by the consumer. In this case, it is reasonable to conclude that applicant's goods come from the place named in the mark, i.e., New York. See, *In re Nantucket Allserve Inc.*, 28 USPQ2d 1144 (TTAB 1993). While as noted herein, we can legally presume that a goods/place association exists, the Examining Attorney has further justified this conclusion with an excerpt from *Webster's New Geographical Dictionary* (1984), which indicates that apparel is among the principal products of New York. Thus, in conclusion, we find that NY JEANS and design is primarily geographically descriptive.

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in applicant's case to "hip," "urban" clothing.

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*Decision:* The refusal to register is affirmed as to both Section 2(d) and Section 2(e)(2) of the Act.

R. F. Cissel

P. T. Hairston

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board